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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/010,475 | 11/08/2001 | Jean-Alec Ducros | 037906.098261 | 4 ⁹⁸³ |

7590 09/12/2003

PITNEY, HARDIN, KIPP & SZUCH LLP
685 Third Avenue
New York, NY 10017-4024

EXAMINER

NILAND, PATRICK DENNIS

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1714

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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PITNEY, HARDIN, KIPP & SZUCH LLP
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New York, NY 10017

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(restarted)

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Office Action Summary

Application No.

10/010,475

Applicant(s)

DUCROS ET AL.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

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1. Claims 12-14 are pending. The International Search Report of the originally filed IDS has not been considered since it is not a reference. If the applicant wishes to have the references thereon considered they should be submitted in accordance with proper procedure. EP 103695, and the Derwent publications were not considered because they were not present in this file and were not available to the examiner otherwise.

2. Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. It is unclear what is encompassed by the instantly claimed "polyoxypolyolefin type". "Polyoxypolyolefin" is not a chemically recognized term. It would appear to require segments of polyolefin and peroxy segments. However, this is not consistent with the single non-limiting example of the claimed "polyoxypolyolefin". The lack of description in the instant specification and the lack of clarity of the term in the art makes it impossible to determine the full scope of "polyoxypolyolefin". "Type" further confuses this terminology. It is unclear what additional species are allowed into the genus of the terminology modified by "type". The word "type" therefore makes the modified terminology indefinite. See *Ex parte Copenhagen*, POBA, 1955, 109 USPQ 118-119.

3. Claims 12-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed polyoxypolyolefin, does not reasonably provide enablement for the entire scope of polyoxypolyolefin type. The specification does not enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. It is unclear what is encompassed by the instantly claimed “polyoxypolyolefin type”.

“Polyoxypolyolefin” is not a chemically recognized term. It would appear to require segments of polyolefin and peroxy segments. However, this is not consistent with the single non-limiting example of the claimed “polyoxypolyolefin”. The lack of description in the instant specification and the lack of clarity of the term in the art makes it impossible to determine the full scope of “polyoxypolyolefin”. “Type” further confuses this terminology. It is unclear what additional species are allowed into the genus of the terminology modified by “type”. The word “type” therefore makes the modified terminology indefinite. See *Ex parte Copenhaver*, POBA, 1955, 109 USPQ 118-119. The instant specification does not clarify this issue since it only gives one non-limiting example of a polyoxypolyolefin and does not define “type” at all.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. no. 3653959 Kehr et al..

Kehr discloses products which fall within the scope of “pad” and are thermally conductive.

Kehr encompasses the instantly claimed mixtures of ingredients at the abstract; column 3, lines

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61-75; column 6, lines 29-55; column 8, lines 60-63; and the remainder of the document. The polyethers of the patentee fall within the scope of the instantly claimed polyoxypolyolefins based on the example of the instant specification. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the patentee's elastomers that fall within the scope of the instant claims and the alumina or other heat conducting fillers because they are encompassed by the patentee and would have given the product properties disclosed by the patentee.

6. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5344635 Bujard et al..

Bujard encompasses the instantly claimed elastomeric polymers and the instantly claimed fillers at the abstract; column 1, lines 14-30; column 3, lines 16-57; column 4, lines 2-7 and 52-62; column 5, lines 31-32 and 67-68; column 6, lines 14; column 7, lines 48-60; and column 8, lines 39-52, which falls within the scope of "pad". It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the patentee's elastomers that fall within the scope of the instant claims and the alumina or other heat conducting fillers because they are encompassed by the patentee and would have given the product properties disclosed by the patentee.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

July 29, 2003



Patrick Niland
Primary Examiner
Art Unit 1714